



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,347	09/25/2001	J. Fernando Bazan	DX0903K1	9754

28008 7590 12/08/2003

DNAX RESEARCH, INC.
LEGAL DEPARTMENT
901 CALIFORNIA AVENUE
PALO ALTO, CA 94304

EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,347

Applicant(s)

BAZAN ET AL.

Examiner

Olga N. Chernyshev

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-31 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6/24/02 oc
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group V in Paper filed September 19, 2003 is acknowledged.

Claims 1-20 have been cancelled and claims 21-24 and 26-32 have been added as requested in the amendment of Paper filed September 19, 2003.

2. The numbering of the newly submitted claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not), emphasis added. In the instant case, misnumbered claims 21-24 and 26-32 have been renumbered 21-31.

3. Newly submitted claims 25-29 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 25-29 are directed to a method of stimulating lymphoid proliferation and development by incubating the cells with IL-B50, classified in class 514, subclass 2, for example. Inventions of elected original Group V, represented by instant claims 21-24 and 30-31, and of newly submitted claims 25-28 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides

Art Unit: 1646

of Group v could be used in an entirely different manner such as for the production of antibodies rather than in the methods of claims 25-29.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86

Art Unit: 1646

(March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 21-24 and 30-31 are under examination in the instant office action.

Specification

5. The use of the trademarks has been noted in this application, see page 62, line 20, for example. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 22-24 and 30-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

Art Unit: 1646

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 22-24 are directed to proteins which have 80% identity to a protein having SEQ ID NO: 2 or to segment 1-131 of SEQ ID NO: 4 or fragments of SEQ ID NO: 2 or 4, capable of binding IL-B50 receptors. Claims 30 and 31 are dependent claims. However, the instant specification fails to describe the entire genus of proteins which are encompassed by these claims. In making a determination of whether the application complies with the written description requirement of 35 U.S.C. 112, first paragraph, it is necessary to understand what Applicant has possession of and what Applicant is claiming. From the specification, it is clear that Applicant has possession of a nucleic acid molecule which encodes a proteins of SEQ ID NO: 2 or SEQ ID NO: 4. The subject matter which is claimed is described above. The claims are drawn to proteins which have 80% identity to a protein having SEQ ID NO: 2 or to segment 1-131 of SEQ ID NO: 4 or fragments of SEQ ID NO: 2 or 4, capable of binding IL-B50 receptors. First, the claims are not limited to a protein with a specific amino acid sequence. The claims only require polypeptides to share some degree of structural similarity to the isolated protein of SEQ ID NO: 2 or 4. The specification only describes a protein having the amino acid sequence of SEQ ID NO: 2 an SEQ ID NO: 4 and fails to teach or describe any other protein which lacks the amino acid sequence of SEQ ID NO: 2 or 4 and is capable of binding IL-B50 receptors. Therefore, there is a lack of teaching regarding structure and function because there is only a single example provided in the specification and because there is no guidance found in the prior art.

Art Unit: 1646

Next in making a determination of whether the application complies with the written description requirement of 35 U.S.C. 112, first paragraph, each claimed species and genus must be evaluated to determine whether there is sufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention at the time the application was filed. With this regard, the instant application fails to provide a written description of the species or the genus which are encompassed by the instant claims except for the proteins of SEQ ID NO: 2 and SEQ ID NO: 4. The specification does not provide a complete structure of those proteins which have 80% identity to a protein having SEQ ID NO: 2 or to segment 1-131 of SEQ ID NO: 4 or fragments of SEQ ID NO: 2 or 4, capable of binding IL-B50 receptors. The claims also fail to recite other relevant identifying characteristics (physical and/or chemical and/or functional characteristics coupled with a known or disclosed correlation between function and structure) sufficient to describe the claimed invention in such full, clear, concise and exact terms that a skilled artisan would recognize applicant was in possession of the claimed invention. The specification fails to provide a representative number of species for the claimed genus (those proteins which have 80% identity to a protein having SEQ ID NO: 2 or to segment 1-131 of SEQ ID NO: 4 or fragments of SEQ ID NO: 2 or 4, capable of binding IL-B50 receptors) because the specification teaches only the two embodiments of SEQ ID NO: 2 and 4. Therefore, the claims are directed to subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1646

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21-24 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 21-24 are vague and indefinite in so far as it employs the term "IL-B50" as a limitation. This term is appears to be novel, and without a reference to a precise amino acid sequence identified by a proper SEQ ID NO: one cannot determine the metes and bounds of "IL-B50 polypeptide". Moreover, because the instant specification does not identify that property or combination of properties which is unique to and, therefore, definitive of a "IL-B50 polypeptide", an artisan cannot determine if a compound which meets all of the other limitations of a claim would then be included or excluded from the claimed subject matter by the presence of this limitation.

9. Claims 30-31 are indefinite for being dependent from indefinite claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1646

11. Claims 21-24 and 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Sims et al. (US Patent 6, 555, 520, April 29, 2003, filed May 9, 2001).

Applicant is advised that the utility of the claimed IL-B50 sequences is fully disclosed only in the instant application, which is a continuation-in-part of the application 09/399,492. Therefore, the effective filing date of the instant application is established as the filing date of the instant application, which is September 09, 2001.

Claims 21-24 are directed to an isolated polypeptide encoded by a nucleic acid of SEQ ID NO: 3, isolated polypeptide comprising amino acid sequence of SEQ ID NO: 4, isolated polypeptide with at least 80% identity to SEQ ID NO: 2 or isolated polypeptide with at least 80% identity to fragment 1-131 of SEQ ID NO: 4. Sims et al. disclose polypeptide and polynucleotide sequences that have 100% identity to the instant SEQ ID NO: 1, 2 and 3, see a copy of the printout of the sequence alignment attached to the instant office action. Thus, Sims et al anticipate the instant claims 21-24.

Claims 30-31 are directed to IL-B50 as a fusion protein and a fusion protein comprising an F_c domain. Sims et al. disclose TSLP polypeptides (of sequences identical to the amino acid nucleic acid sequences of IL-B50 of the instant invention, see paragraph above) as fusion proteins comprising an F_c polypeptide from an antibody (see column 12, lines 27-65). Thus, the disclosure of Sims et al. meets the limitations of claims 30-31.

Conclusion

12. No claim is allowed.

Art Unit: 1646

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-0294 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/963,347

Page 10

Art Unit: 1646

Olga N. Chernyshev, Ph.D.

A handwritten signature in black ink, appearing to read "Olga N. Chernyshev", written in a cursive style.